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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,447	03/20/2002	Hiroyuki Yoshida	107348-00219	7039

4372 7590 04/22/2003

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EXAMINER

NGUYEN, TU MINH

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 04/22/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/070,447

Applicant(s)
Yoshida et al.

Examiner
Tu M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 7, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 20, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. An Applicant's Amendment filed on February 7, 2003 has been entered. Claims 1, 3, and 6 have been amended. Overall, claims 1-6 are pending in this application.

The arguments with respect to the references applied in the previous Office Action were deemed persuasive; accordingly, a new non-final rejection is set forth below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (U.S. Patent 6,053,785) in view of Nakase et al. (U.S. Patent 4,811,560).

Re claim 3, as shown in Figure 5, Kato et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (83) for purifying an exhaust gas discharged from an engine (14) is mounted in an exhaust passage for guiding the exhaust gas, wherein at least a portion of the exhaust passage is integrally formed in a case member (15) which is disposed under an engine block (33) to accommodate a drive shaft (21) therein for

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transmitting a driving force from the engine (14) to a propeller (24); the catalytic converter (83) is disposed in a space surrounded by the case member (15).

Kato et al., however, fail to disclose that the structure further comprises a connection into which the exhaust passage opens is formed in a side wall of the case member; and a lid detachably coupled to the connection.

As illustrated in Figures 4 and 7, Nakase et al. teach an exhaust system for marine propulsion, that includes an extending expansion chamber (this chamber shown in Figure 7 is an extension of a chamber (58)) formed in a side wall of a case member (47); the expansion chamber comprises a connection (a plane where numeral (63) is located) into which an exhaust passage opens is formed and extend into and a lid (61) detachably coupled to the connection. It would have been obvious to one having ordinary skill in the art at the time of the invention was made, to have designed and built the expansion chamber taught by Nakase et al. into the structure of Kato et al., since the application thereof would have extended an exhaust passage to prevent the likelihood of water reentering the engine (see the Abstract of Nakase et al.).

Re claim 4, in the modified structure of Kato et al., the catalytic converter (83) is supported on the lid ((61) in Nakase et al.).

Re claim 5, in the modified structure of Kato et al., the catalytic converter (83) is supported on the case member (15).

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Re claim 6, as shown in Figures 4 and 5, Kato et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (83) for purifying an exhaust gas discharged from an engine (14) is mounted in an exhaust passage for guiding the exhaust gas, wherein at least a portion of the exhaust passage and an oil pan (107) for restoring a lubricating oil for the engine (14) are integrally formed in a case member (15) which is disposed under an engine block (33) to accommodate a drive shaft (21) therein for transmitting a driving force from the engine (14) to a propeller (24); the catalytic converter (83) is disposed in a space surrounded by the case member (15).

With regard to the preamble directed to a 4-cycle engine, a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, *supra* at 480. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending claim 6 does not rely on the preamble for completeness.

Kato et al., however, fail to disclose that the structure further comprises a connection into which the exhaust passage opens is formed in a side wall of the case member; and a lid detachably coupled to the connection.

As illustrated in Figures 4 and 7, Nakase et al. teach an exhaust system for marine propulsion, that includes an extending expansion chamber (this chamber shown in Figure 7 is an extension of a chamber (58)) formed in a side wall of a case member (47); the expansion chamber

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comprises a connection (a plane where numeral (63) is located) into which an exhaust passage opens is formed and extend into and a lid (61) detachably coupled to the connection. It would have been obvious to one having ordinary skill in the art at the time of the invention was made, to have designed and built the expansion chamber taught by Nakase et al. into the structure of Kato et al., since the application thereof would have extended an exhaust passage to prevent the likelihood of water reentering the engine (see the Abstract of Nakase et al.).

Allowable Subject Matter

4. Claims 1 and 2 are allowed.

Response to Arguments

5. Applicant's arguments with respect to the references applied in the previous Office Action have been considered but are moot in view of the new ground(s) of rejection.

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Communication

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tu Nguyen whose telephone number is (703) 308-2833.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas E. Denion, can be reached on (703) 308-2623. The fax phone number for this group is (703) 308-7763.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Tu M. Nguyen

TMN

Tu M. Nguyen

April 20, 2003

Patent Examiner

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Thomas Denion
THOMAS DENION
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700